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SEP 17 2004

OFFICE OF PETITIONS

In re Application of
Arguelles
Application No. 10/717,214
Filed: November 19, 2003
Attorney Docket No. 13430US/I435.105.101
For: PROCESS AND DEVICE FOR TESTING A
SERIALIZER CIRCUIT ARRANGEMENT AND
PROCESS AND DEVICE FOR TESTING A
DESERIALIZER CIRCUIT ARRANGEMENT

:
: DECISION REFUSING
: STATUS UNDER
: 37 CFR 1.47(b)

This is in response to the petition under 37 CFR 1.47(b), filed July 2, 2004 (certificate of mailing date June 30, 2004).

The petition under 37 CFR 1.47(b) is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)." Failure to respond will result in abandonment of the application.

The above-identified application was filed on November 19, 2003 without an executed oath or declaration. Accordingly, on February 20, 2004, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration, filing fees, and a surcharge for their late filing.

In response, on July 2, 2004 (certificate of mailing date June 30, 2004), a petition for a three month extension of time and required fee, a declaration signed by Attorney Paul P. Kempf on behalf of Infineon Technologies AG, a party with purported proprietary interest in the invention, the surcharge, filing fees, the petition fee, and the instant petition were filed. A declaration of facts by Axel Schaich, Senior Patent Counsel for Infineon Technologies AG, accompanies the petition.

Mr. Schaich states that he personally gave the complete application to Inventor Arguelles and that Mr. Arguelles orally refused to sign the declaration for patent application.

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration;

- (2) an acceptable oath or declaration;
- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest; and
- (6) proof of irreparable damage.

Applicant lacks item (2), and (5) set forth above.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. Mr. Arguelles' citizenship is not included on the oath or declaration. The citizenship of the inventor must be included on the oath or declaration. As listing the citizenship for the inventor is a statutory requirement under 35 USC 115, it cannot be waived. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicant on behalf of the non-signing inventor is REQUIRED. See MPEP 409.03(a).

As to item (5), Rule 47 applicant has failed to show that Infineon Technologies AG has sufficient proprietary interest in the subject matter to justify the filing of the application for the non-signing inventor (see MPEP 409.03(f)). The referenced assignment document between Infineon Technologies AG and the non-signing inventor is not in the official electronic file for this application and has not yet been entered in Office computer records. Therefore, petitioner has not established proprietary interest. The undersigned requests petitioner submit another copy of the assignment with any reconsideration petition. Please label it as an exhibit to the reconsideration petition and type/write in capital letters that it is a copy of a previously submitted assignment. This should result in the assignment document being scanned into our electronic system, rather than immediately forwarded to assignments branch without being scanned.

A courtesy copy will be mailed to the address listed on the petition

Further correspondence with respect to this matter should be addressed as follows:

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Inquiries may be directed to the undersigned at (703)308-6712.

A handwritten signature in black ink, appearing to read "E. Shirene Willis".

E. Shirene Willis
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cc: PAUL P. KEMPF
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